

REMARKS

In response to the Patent Office Action of December 1, 2004, the Applicants respectfully request reexamination and reconsideration. To further the prosecution of this application, amendments have been made in the claims and one new claim has been added to the application, namely, claim 4.

Regarding the Patent Office Letter, the Examiner has set forth a rejection of claims 1-3 under 35 U.S.C. §103(a) relying upon the '255 and '348 patents to Casey. In making this rejection the Examiner has set forth an Attachment #1 to describe the claim sections. For the straight section the Examiner relies on the lug 22. For the arcuate shaped section, the Examination relies upon the beam portion 36. In Attachment #1 the Examiner indicates that the claimed first portion is depicted by "circles" and the claimed second portion by "stars".

In the Casey '255 patent it is noted that the lug 22 and beam 36 are manufactured from a substantially rigid plastic material. This is because the upper and lower jaws in this prior art patent have to be sufficiently strong when the clip is closed to occlude the fallopian tube.

In the Casey '255 patent the upper jaw comprises a main load bearing or beam portion 34 (see column 4 at line 1) which is essentially straight particularly at its outer contact surface. The portion 36 is provided with a reduced center cross-section area into which the tongue 49 fits when the clip is closed. The lug 22 forms the hinge bearing and is not part of the upper jaw, at least with respect to any bending action.

It is also noted that the Examiner has combined the '255 patent with the '348 patent in making a rejection under 35 U.S.C. §103. However, in view of the amendments now made in the claims, it is believed that this rejection is now moot.

Thus, the prior art relied upon by the Examiner does not teach the now claimed arcuate portions particularly any arcuate outer contact surface.

The Applicants' position is further substantiated by other statements found in the '255 patent. In column 4 at lines 30-45 it is noted that when the clip is fully closed the tongue 49 is

compressed "flat" against the upper jaw 36. Thus, in the '255 patent the combination of the beam 36 and the tongue 49 provide an essentially non-arcuate configuration. Moreover, the '255 patent does not teach any arcuate portion on an outer contact surface as in accordance with the present invention.

The clip of the present invention as now defined in amended claim 1, defines the first and second portions as arcuate shaped portions. Moreover, the first arcuate shaped portion is now defined as having a first radius of curvature on at least its outer contact surface that is substantially greater than the radius of curvature of the second arcuate shaped portion. In the '255 patent the outer surface where the reference character 12 points to in Fig. 1 is absolutely straight and has no arcuate portion thereto.

It is the Applicants' position that the prior art relied upon by the Examiner does not teach the two different radii in combination with the straight section. This arrangement allows the clip to be fed down a small diameter tube in a semi-closed position to be openable at the end of the tube and to then be latched without risk of the upper jaw being distorted when the latching pressure is applied.

An amendment has also been made in claim 2 so that the language in claim 2 is consistent with the amendments made in claim 1.

Claims 4-6 have also been added to the application to recite additional distinguishing features. For example, in claim 4 there is defined a distal generally straight section including a free end that extends in a direction distally of the hinge. In the '255 patent the spike 28 does not extend distally but rather extends proximally. Claims 5 and 6 also claim the feature of the upper jaw, in accordance with the present invention, being of the same width therealong. This is not the case with respect to the '255 patent.

CONCLUSION

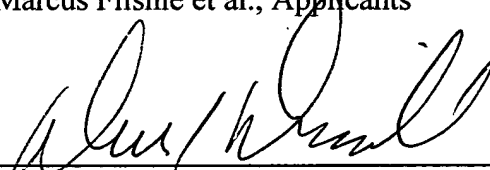
In view of the foregoing amendments and remarks, the Applicants respectfully submit that all of the claims pending in the above-identified application are in condition for allowance, and a notice to that effect is earnestly solicited.

If the present application is found by the Examiner not to be in condition for allowance, then the Applicants hereby request a telephone or personal interview to facilitate the resolution of any remaining matters. Applicants' attorney may be contacted by telephone at the number indicated below to schedule such an interview.

The U.S. Patent and Trademark Office is authorized to charge any additional fees incurred as a result of the filing hereof or credit any overpayment to our deposit account #19-0120.

Respectfully submitted,
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